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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,654	08/14/2000	Roger William Gutwein	7718M	9656

27752 7590 01/13/2003

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EXAMINER

WEIER, ANTHONY J

ART UNIT PAPER NUMBER

1761

DATE MAILED: 01/13/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/638,654	GUTWEIN ET AL.	
	Examiner	Art Unit	
	Anthony Weier	1761	

RG

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Applicant Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 8-33 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the original specification does not appear to support the ranges for brew solids and Delta Standard Yield now set forth in claim 8. More specifically, the instant specification discloses a Delat Standard Yield of less than 8%. As for the brew solids, various amounts are set forth in the examples that are less than 30%, but no upper limit of 30% is set forth. The Examiner notes the reference to "30%" on page 5, line 7, but this is in reference to the brew solid results of prior art products. There is, however, no reference to specifically "less than about 30%" for the the present invention.

2. Claims 8-19, 24-26, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0893065.

The claims are rejected for the reasons set forth in the last Office Action (Paper No. 7, mailed 4/24/02) with the addition of the following. The claims now further call for an upper limit of brew solids and a Delta Standard Yield of less than about 10%.

Although EP 0893065 discloses preparation of extracts with higher brew solids, there is also disclosed the prior art use of extracts with brew solids of as low as 15% (pages 2

and 3) wherein same have been packaged. Though the shelf-life of such extracts is considered unstable in EP 0893065, they, nevertheless, have been prepared. If it is shown that extracts meeting the brew solid amount of the instant invention have not been stored for the time called for in the instant claims, it would have been obvious to

one having ordinary skill in the art at the time of the invention to have done so. In particular, EP 0893065 further discloses previous packaged coffee extracts which have been stored for as high as six months (see page 2). Clearly, it would have been obvious to have held same for such a long period to test the stability of same, the central concern in EP 0893065.

As for the Delta Standard Yield, if it is shown that same is not inherently present in the extracts discussed above in EP 0893065, it would have been obvious to one having ordinary skill in the art at the time of the invention to have prepared same as a matter of preference depending, for example, the particular taste desired in the final product. The Examiner does not have a lab to test the Delta Standard Yield of such extracts, and the burden for persuading otherwise rests on Applicants

3. Claims 8-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalenian.

The claims are rejected for the reasons set forth in the last Office Action (Paper No. 7, mailed 4/24/02) with the addition of the following. The claims now further call for an upper limit of brew solids and a Delta Standard Yield of less than about 10%.

Kalenian further discloses the use of an extract having a brew solid "in excess of 10% wt" (col. 9, lines 27-29). Such range overlaps that called for in the instant claims ("less

than about 30%). As for the Delta Standard Yield, if it is shown that same is not inherently present in the extracts discussed Kalenian, it would have been obvious to one having ordinary skill in the art at the time of the invention to have prepared same as a matter of preference depending, for example, the particular taste desired in the final

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product. The Examiner does not have a lab to test the Delta Standard Yield of such extracts, and the burden for persuading otherwise rests on Applicants.

4. Applicant's arguments filed 10/15/02 have been fully considered but they are not persuasive. Said arguments have been addressed in the rejections as set forth above.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 703-308-3846. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for

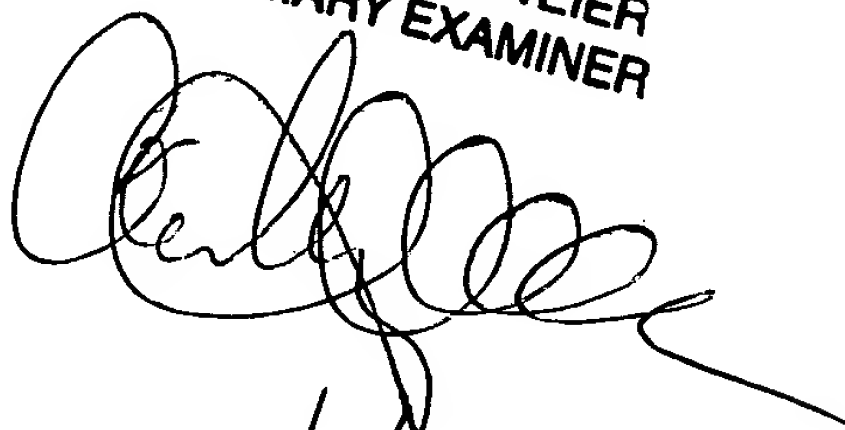
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the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Anthony Weier
January 9, 2003

ANTHONY J. WEIER
PRIMARY EXAMINER



1/9/03